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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,675	06/22/2000	Mark Herrmann	10984-287001	7511
26161	7590	11/01/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			JACOBS, LASHONDA T	
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			2157	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/599,675	<b>Applicant(s)</b> HERRMANN ET AL.	
	<b>Examiner</b> LaShonda T. Jacobs	<b>Art Unit</b> 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 and 33-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-32 and 39-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

This Office action is in response to Applicants' Amendment/Request for Reconsideration filed on August 11, 2003. Claims 1-24 and 33-38 have been cancelled. Claims 25, 27, 28, 29 and 31 have been amended. Claims 25-32 are presented for further examination. Newly added claims 39-65 are presented for examination

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 39-42, 45-46, 48-51, 54-55 and 58-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldberg et al (hereinafter, "Goldberg", U.S. Pat. No. 5,823,879).

As claims 39, 48 and 62, Goldberg discloses a method, software product stored on a computer readable medium and system comprising:

- displaying a user interface on display permitting a user to participate in an interactive activity (abstract, col. 3, lines 57-67 and col. 4, line 1);
- during the display of the user interface, displaying advertising information on the same display without interfering with the user's ability to participate in the interactive activity (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user

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- to participate in an interactive game and request additional information relating to an advertisement);
- during the display of the user interface, receiving from the user a first signal indicating an interest in receiving additional information related to the advertisement information (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement); and
  - causing said additional information related to the advertising information to be provided to the user in response to the first signal, without interfering with the user's ability to participate in the interactive activity (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement).

As per claims **40** and **49**, Goldberg discloses:

- wherein the interactive activity is a game, and wherein the advertising information is displayed during the game, the first signal is received from the user during the game, and said additional information is provided to the user without interrupting the game (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement).

As per claims **41** and **50**, Goldberg discloses:

- wherein the user interface is provided by a client computer connected over a network to a server computer, and wherein causing said additional information to be provided to the

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user comprises transmitting from the client to the server a second signal indicating the user's interest in receiving the additional information (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement).

As per claims **42** and **51**, Goldberg discloses:

- wherein the second signal is transmitted from the client to the server in response to user operation of the user interface to transmit information related to the interactive activity from the client to the server (col. 4, lines 48-62, col. 18, lines 55-67 and col. 19, lines 1-19).

As per claims **45** and **54**, Goldberg further discloses:

- including registering the user prior to displaying the user interface (col. 5, lines 4-24).

As per claims **46** and **55**, Goldberg discloses:

- wherein causing said additional information related to the advertising information to be provided to the user in response to the first signal, without interrupting the user's ability to participate in the interactive activity, includes causing registration information for the user to be retrieved (col. 4, lines 48-62, col. 25, lines 30-55, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement).

As per claim **57**, Goldberg discloses a method comprising:

- providing a user interface that permits a user to participate in an interactive activity (abstract, col. 3, lines 57-67 and col. 4, line 1); and

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- during the user's interaction with the user interface, permitting the user to signal interest in receiving advertising information without interfering with the user's participation in the interactive activity (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement).

As per claim **58**, Goldberg further discloses:

- receiving from the user a signal indicating interest in receiving advertising information and providing the advertising information to the user in response to the signal (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement).

As per claim **60**, Goldberg discloses a method comprising:

- displaying information about an interactive activity to a user on a display associated with a client computer (abstract, col. 3, lines 57-67 and col. 4, line 1);
- receiving at the client computer a request for advertising information and information related to the user's participation in the interactive activity (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement); and
- simultaneously transmitting to a server the user's request for advertising information and the information related to the user's participation in the interactive activity (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg

allows a user to participate in an interactive game and request additional information relating to an advertisement).

As per claim 61, Goldberg discloses:

- wherein said simultaneous transmission is performed in response to the user providing information related to the user's participation in the interactive activity (col. 4, lines 48-62, col. 18, lines 55-67 and col. 19, lines 1-19).

As per claim 63, Goldberg discloses a method comprising:

- providing a user interface that permits a user to participate in an interactive activity having a beginning and an end, the user interface being capable of receiving user inputs relating to the interactive activity (col. 4, lines 48-62, col. 18, lines 55-67 and col. 19, lines 1-19); and
- after the beginning and prior to the end of the interactive activity, permitting the user to signal interest in receiving advertising information without disabling the ability of the user interface to receive user inputs relating to the interactive activity (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **25-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Spaur et al (hereinafter, "Spaur". 6,196,920) in view of Goldberg.

As per claim **25**, Spaur discloses a system comprising:

- a server communicatively coupled to client device and configured to communicate content to the client device for display to a user, (abstract, col. 3, lines 16-49, col. 6, lines 39-67, col. 7, lines 1-20, and col. 14, lines 11-35).

However, Spaur does not explicitly disclose:

- wherein the content includes information relating to an interactivity and information relating to an advertisement; and
- one or more software modules executing in an operating environment provided by the server and configured (a) to receive input from the client device, said input including, in a single transmission, information relating to the user's participation in the interactive activity and a request from the user to receiving additional information relating to the advertisement, and (b) after receiving said input, provide to the user additional information relating to the advertisement and to communicate content to the client relating to the interactive activity.

In an analogous art, Goldberg discloses a network gaming system comprising:

- wherein the content includes information relating to an interactivity and information relating to an advertisement (paragraph 0163; Goldberg teaches that a user is allowed to continue playing a game and received further information about an advertisement); and



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- one or more software modules executing in an operating environment provided by the server and configured (a) to receive input from the client device, said input including, in a single transmission, information relating to the user's participation in the interactive activity and a request from the user to receiving additional information relating to the advertisement, and (b) after receiving said input, provide to the user additional information relating to the advertisement and to communicate content to the client relating to the interactive activity (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement).

Given the teaching of Goldberg, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Spaur by allowing a user to request and view additional advertisement information while playing an online game in order to greatly increase the cost effectiveness of advertising.

As per claim **27**, Spaur implicitly discloses:

- a web browser executing in an operating environment provided by the client device receive a request from the user to receive additional information relating to advertisement, (col. 6, lines 23-63 and col. 14, lines 28-36).

As per claim **28** Spaur discloses:

- wherein the media comprises a web-based computer game (abstract, col. 1, lines 13-19, col. 6, lines 64-67, and col. 7, lines 1-5).

As per claim **32**, Spaur discloses:

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- wherein communicating the advertising information to the user includes sending an electronic mail message to the user (col. 14, lines 28-36).

5. Claims **43-44**, **47**, **52-53** and **56-57** are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg in further view of Shaw et al (hereinafter, "Shaw", 6,199,106).

As per claims **43** and **52**, Goldberg discloses the invention substantially as claims discussed above.

However, Goldberg does not explicitly disclose:

- wherein causing said additional information to be provided to the user includes causing an electronic mail message to be sent to the user.

Shaw discloses an electronic mail system with advertising that allows the user to select the more information button to send additional information about the product or service by email to the user (col. 6, lines 1-8). Therefore, Shaw implicitly discloses wherein causing said additional information to be provided to the user includes causing an electronic mail message to be sent to the user.

Given the teaching of Shaw, it would have been obvious to one of ordinary skill in the art to modify Spaur in view of Goldberg by including a more information button in the input area to allow a user to obtain additional information about a product or service in order to learn more about the product or service.

As per claims **44** and **53**, Goldberg discloses the invention substantially as claims discussed above.

However, Goldberg does not explicitly disclose:

- wherein the first signal is generated in response to the user checking a check box in the user interface.

Shaw discloses an electronic mail system with advertising that allows the user to select the more information button to send additional information about the product or service by email to the user (col. 6, lines 1-8). Therefore, Shaw implicitly discloses wherein the first signal is generated in response to the user checking a check box in the user interface.

Given the teaching of Shaw, it would have been obvious to one of ordinary skill in the art to modify Spaur in view of Goldberg by including a more information button in the input area to allow a user to obtain additional information about a product or service in order to learn more about the product or service.

As per claims 47 and 56, Goldberg discloses:

- wherein causing said additional information related to the advertising information to be provided to the user in response to the first signal, without interrupting the user's ability to participate in the interactive activity (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement)

However, Goldberg does not explicitly disclose:

- capturing an email address of the user.

Shaw discloses an electronic mail system with advertising that allows the user to select the more information button to send additional information about the product or service by email to

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the user (col. 6, lines 1-8). Therefore, Shaw implicitly discloses capturing an email address of the user.

Given the teaching of Shaw, it would have been obvious to one of ordinary skill in the art to modify Spaur in view of Goldberg by including a more information button in the input area to allow a user to obtain additional information about a product or service in order to learn more about the product or service.

As per claim **59**, Goldberg discloses the invention substantially as claims discussed above.

However, Goldberg does not explicitly disclose:

- wherein the advertising information is provided by sending electronic mail to the user..

Shaw discloses an electronic mail system with advertising that allows the user to select the more information button to send additional information about the product or service by email to the user (col. 6, lines 1-8). Therefore, Shaw implicitly discloses wherein the advertising information is provided by sending electronic mail to the user..

Given the teaching of Shaw, it would have been obvious to one of ordinary skill in the art to modify Spaur in view of Goldberg by including a more information button in the input area to allow a user to obtain additional information about a product or service in order to learn more about the product or service.

As per claim **64**, Goldberg discloses a method comprising:

- in response to an input received from a user playing a game through a game interface (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12).

However, Goldberg does not explicitly discloses:

- automatically transmitting an electronic message while the user is playing the game, the electronic message being accessible after the user has completed playing the game.

Shaw discloses an electronic mail system with advertising that allows the user to select the more information button to send additional information about the product or service by email to the user (col. 6, lines 1-8). Therefore, Shaw implicitly discloses automatically transmitting an electronic message while the user is playing the game, the electronic message being accessible after the user has completed playing the game.

Given the teaching of Shaw, it would have been obvious to one of ordinary skill in the art to modify Spaur in view of Goldberg by including a more information button in the input area to allow a user to obtain additional information about a product or service in order to learn more about the product or service.

As per claim 65, Goldberg discloses the invention substantially as claims discussed above.

However, Goldberg does not explicitly disclose:

- wherein the electronic message contains advertising information.

Shaw discloses an electronic mail system with advertising that allows the user to select the more information button to send additional information about the product or service by email to the user (col. 6, lines 1-8). Therefore, Shaw implicitly discloses wherein the electronic message contains advertising information.

Given the teaching of Shaw, it would have been obvious to one of ordinary skill in the art to modify Spaur in view of Goldberg by including a more information button in the input area to allow a user to obtain additional information about a product or service in order to learn more about the product or service.

6. Claim **29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Spaur in view of Goldberg and in further view of Shaw et al (hereinafter, "Shaw", 6,199,106).

As per claim **29**, Spaur in view of Goldberg discloses the invention substantially as claimed.

However, Spaur in view of Goldberg does not explicitly disclose:

- wherein the input area comprises a check box and communicating advertising information to the user includes communicating information to the user when the check box is selected.

Shaw discloses an electronic mail system with advertising that allows the user to select the more information button to send additional information about the product or service by email to the user (col. 6, lines 1-8). Therefore, Shaw implicitly discloses wherein the input area comprises a check box and communicating advertising information to the user includes communicating to the user when the check box is selected.

Given the teaching of Shaw, it would have been obvious to one of ordinary skill in the art to modify Spaur in view of Goldberg by including a more information button in the input area to allow a user to obtain additional information about a product or service in order to learn more about the product or service.

7. Claims **26** and **30-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Spaur in view of Goldberg and in further view of Heckel.

As per claim **26**, and **31**, Spaur in vie of Goldberg discloses the invention substantially as claimed.

However, Spaur in view of Goldberg does not explicitly disclose:

- wherein communicating the advertising information includes retrieving the registration information from a registration database.

In an analogous art, Heckel discloses:

- wherein communicating the advertising information includes retrieving the registration information from a registration database (col. 4, lines 20-27, and lines 35-58).

Given the teaching of Heckel, it would have been obvious to one of ordinary skill in the art to modify Spaur in view of Goldberg by including retrieving registration information from the registration database when communicating advertising information in order to match advertisements with demographic data of the user allowing the server to display appropriate advertisements to user.

As per claim 30, Spaur in view of Goldberg discloses the invention substantially as claimed.

However, Spaur in view of Goldberg does not explicitly disclose:

- registering the user prior to displaying the media.

In an analogous art, Heckel discloses:

- registering the user prior to displaying the media (col. 4, lines 35-38).

Given the teaching of Heckel, it would have been obvious to one of ordinary skill in the art to modify Spaur in view of Goldberg by registering the user prior to displaying the media in order to authenticate his or herself to allow for retrieval of the game and any demographic data for the display of advertisements.

*Response to Arguments*

8. Applicant's arguments with respect to claims **25-32** and **39-65** have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pub. No. 2002/0013167 to Spaur et al

U.S. Pat. No. 6,625,578 to Spaur et al

U.S. Pat. No. 5,643,088 to Vaughn et al

U.S. Pat. No. 6,264,560 to Goldberg et al

U.S. Pat. No. 6,183,366 to Goldberg et al

U.S. Pat. No. 6,712,702 to Goldberg et al

U.S. Pub. No. 2005/0148377 to Goldberg et al

U.S. Pat. No. 6,928,615 to Haitzuka et al

U.S. Pub. No. 2001/0039546 to Moore et al

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after



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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShonda T. Jacobs whose telephone number is 571-272-4004. The examiner can normally be reached on 8:30 A.M.-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShonda T Jacobs  
Examiner  
Art Unit 2157

ltj  
October 20, 2005

  
ARIO ETIENNE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100